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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/690,377 | 10/21/2003 | Yoshiyuki Uemura | NSG-209US1 | 6516 |
| 23122 | 7590 | 05/25/2006 | EXAMINER | |
| RATNERPRESTIA | | | LUU, THANH X | |
| P O BOX 980 | | | ART UNIT | PAPER NUMBER |
| VALLEY FORGE, PA 19482-0980 | | | 2878 | |

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,377

Applicant(s)

UEMURA, YOSHIYUKI

Examiner

Thanh X. Luu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to amendments and remarks filed May 12, 2006. Claims 1-5 are currently pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 3-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It appears that Applicant has failed to originally disclose an embodiment in which the distance between the guide rail and the contact image sensor unit is changed "during the reading of the light transmitting original."

Examiner invites Applicant to cite specific sections of the disclosure that supports such language. Otherwise, Examiner reminds Applicant that no new matter may be added.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Tsai (U.S. Patent 5,900,951).

Regarding claim 1, Tsai discloses (see Fig.) an image reading apparatus of a contact image sensor type for reading a light transmitting original by moving a contact image sensor (103) on a guide rail (104), wherein a distance from an original surface (102) of the light transmitting original to the contact image sensor unit is adjusted (with element 105) by changing a position of a surface of the guide rail on which the contact image sensor unit moves, to maintain a resolution.

5. Claims 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Ando (U.S. Patent 5,362,958).

Regarding claims 3-5, Ando discloses (see Figs. 6b and 7) an image reading apparatus of a contact image sensor type for reading a light transmitting original (page of a book) by moving a contact image sensor (10) on a guide rail (212), including a lifting mechanism (see Fig. 7), positioned between the guide rail and the contact image sensor unit, the lifting mechanism being configured to adjust a distance from an original surface (at 1) of the light transmitting original to the contact image sensor unit, the lifting mechanism being configured to change the distance between the guide rail and the contact image sensor unit during the reading of the light transmitting original to maintain a resolution. Ando also discloses (see Fig. 18) stepwise adjustment (with stepper motor controller (18a)) with a jack mechanism (71).

Allowable Subject Matter

6. Claims 2 and 5 as dependent from claim 1 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed May 12, 2006 have been fully considered but they are not persuasive.

With regard to claim 1, Applicant asserts that Tsai does not disclose a guide rail. Examiner disagrees. Tsai specifically discloses (see col. 2, line 35) the elements 104 are "guide bars." It is unclear how Applicant's guide "rail" is different from a guide "bar." Furthermore, Applicant's reliance on element 106 is unfounded as no such element is claimed or referred to in the rejection. As understood, a position of the surface of the guide rail (104) is changed by the elastic element (105). Without the elastic element, the position of a surface of the guide rail and a distance from the original surface to the CIS would be different. Therefore, the distance from the original surface to the CIS is adjusted by changing a position of a surface of the guide rail as claimed. Examiner notes that Applicant simply uses a "wherein" clause and which fails to structurally distinguish itself from the prior art.

8. With regard to the other claims, Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in

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this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh X. Luu whose telephone number is 571-272-2441. The examiner can normally be reached on M-F 6:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).



Thanh X Luu
Primary Examiner
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05/2006